

## REMARKS

Entry of the present amendment and favorable reconsideration and allowance of this application are requested.

### **1. Discussion of Amendments**

By way of the amendment instructions above, claims 17-22 have been presented and define aspects of the presently claimed inventions to which applicants are deemed entitled. In this regard, claims 17 and 18 are based on the disclosure appearing at page 8, lines 21-22 but are dependent from claims 1 and 7, respectively. Claims 19-22 on the other hand are based on the disclosure at page 4, lines 20-27. Claims 19-20 are dependent from claim 1 and claims 21-22 are dependent from claim 7.

An obvious typographical error inadvertently previously introduced into claim 9 has been corrected.

Therefore, following entry of this amendment, claims 1-22 will be pending herein for which favorable action on the merits is solicited.

### **2. Response to 35 USC §§102 and 103 Rejections**

The Examiner persists in his prior rejections of record. In this regard, claims 1-5 and 16 have been rejected alternatively under 35 USC §§102 (b) or 103(a) as allegedly being anticipated by or obvious over Bonte et al (USP 6,380,290). In addition, claims 6-13 were rejected under 35 USC §103(a) as allegedly obvious over Bonte et al. Finally, claims 14-15 attracted a rejection under 35 USC §103(a) as allegedly obvious over Bonte et al in view of Tieke (USP 5,122,303). Applicants respectfully disagree.

With regard to the alleged anticipation by Bonte et al, applicants note that the Examiner's position appears to be that there is some overlap between what Bonte et al inherently provides in terms of the unsaturation content of vinyl and allyl groups and that

claimed by the present invention – specifically, 36 meq/kg for Bonte et al and *less than 35 meq/kg* for pending claim 1 of the subject application. Applicants are quite frankly perplexed by this assertion.

In this regard, applicants note that the issue in *In re Woodruff*<sup>1</sup> was the disclosure in a prior art reference (i.e., the “McGill patent”) of a range of *about 1-5%*. The issue therefore was whether such a range of *about 1-5%* allowed for concentrations slightly above 5% since the appellant in *Woodruff* was arguing that there was no overlap with a claim which recited “more than 5%”. The Court acknowledged that the disclosure of “about 1-5% would in fact allow for concentrations of slightly above 5% and hence concluded there was overlap in such disclosure with the appellant’s claimed range of “more than 5%.”<sup>2</sup>

Here of course there is no explicit disclosure at all in Bonte et al as to the amount of unsaturation present. The only reason the level of unsaturation of Bonte et al is known is because the present applicants have measured it. The only reason the present applicants measured it was because of the knowledge of claim 1. A reader of Bonte et al would therefore be given no hint whatsoever as to the level of unsaturation present in Bonte et al. And if such a reader measured it based on Bonte et al’s disclosure, then such a person would arrive at an unsaturation level which was clearly outside the range as claimed – i.e., 36 meq/kg for Bonte et al and *less than 35 meq/kg* as claimed.

No overlap between Bonte et al and the present claims with respect to the amount of unsaturation present in fact exists. And as noted above the Examiner’s reliance on *in re Woodruff* is inappropriate under the present facts.

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<sup>1</sup> 16 USPQ2d 1934 (Fed.Cir. 1990).

<sup>2</sup> “We agree, however, with the Board that the disclosure in the McGill patent of a carbon monoxide concentration of ‘*about 1-5%*’ does allow for concentrations slightly above 5%.” *Id.* at 1936.

The Examiner's reliance on *In re Wertheim*<sup>3</sup> is likewise flawed. In *Wertheim* the issue presented was that there was in fact overlap of a claimed range that was within the ranges described in the interfering application. Thus, it was found that the claimed range of "at least 35%" read literally on the range of 25-60% and that a claimed range of "between 35 and 60% read literally on a range within the described broad range o 25% to 60%". Thus, in *Wertheim* it was likewise clear that there was factual overlap between the claimed ranges and the described ranges. As noted above, however, there is in fact no overlap between the claimed unsaturation range and the unsaturation provided by the disclosure of Bonte et al.

The Court in *Wertheim* also observed that:

"As in cases involving the enablement requirement [citation omitted], we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize *in the disclosure* [or a reference] a description of the invention defined by the claims."<sup>4</sup>

Here the Examiner has proffered no evidence as to why persons skilled in the art would recognize in the *disclosure* of Bonte et al a description of an unsaturation content of *less than 35 meq/kg* as is defined by the pending claims herein. Nor can he.

As noted above, the *only* reason the unsaturation amount of Bonte et al is known at all is that the present applicants have measured it in order to establish the differences between Bonte et al and the presently claimed invention. Bonte et al per se does not provide any disclosure as to the unsaturation content of the copolyetheresters therein.

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<sup>3</sup> 191 USPQ 90 (CCPA 1976).

<sup>4</sup> *d. a 97*, emphasis added.

What is in fact known in the art however is that, in order to achieve low levels of unsaturation (i.e., a level of unsaturation of *less than 35 meq/kg*), then certain special measures must taken in the production process of the polyether. This is explained in the application as filed on page 5, lines 2-23. There it is noted that the PO-EO polyols may be prepared by a conventional method, however in order to obtain a low level of unsaturation, an after-treatment must be carried out (see lines 11-19). This special after-treatment is generally not done, since it is very time consuming (see lines 20+). So in general block copolyetherester elastomers will have a level of unsaturation that is higher than 35 meq/kg.

This art recognized fact is confirmed by Bonte et al wherein the elastomer has a level of unsaturation above 35 meq/kg, specifically 36 meq/kg. The polymers disclosed in Bonte et al did not undergo the special post-treatment to lower the amount of unsaturation and as such would not possess such a low level of unsaturation as that claimed in the present application.

Thus, Bonte et al cannot anticipate the presently claimed invention under 35 USC §102(b).

The Examiner apparently is of the position that, even if the 36 meq/kg unsaturation content in Bonte is anticipatory, then it nonetheless renders the presently claimed invention "obvious" (35 USC §103(a)) as it would amount to no more than routine experimentation for the skilled person to use a polymer having an unsaturation content of less than 35 meq/kg. This assertion is not true for at least the following two reasons:

First, Bonte et al does not discuss the level of unsaturation in the polymer at all. Again, the present applicants only know of such a parameter since the applicants measured it. And the applicants measured it because applicants knew about claim 1 of the present application.

So Bonte et al gives no indication to change the level of unsaturation. Moreover, Bonte et al also gives no hint to even start at an unsaturation level of 36 meq/kg. Since the unsaturation level according to Bonte et al is not explicitly disclosed at all, then certainly Bonte et al gives no suggestion for one of ordinary skill in this art to go below an unsaturation content of 36 meq/kg – a value which is only inferentially obtained by actual testing the Bonte et al polymer.

Secondly, changing the level of unsaturation is not in the area of routine experimentation, since a special and unusual post-treatment must be carried out in order to achieve an unsaturation level of less than 35 meq/kg.

For these reasons, Bonte et al likewise cannot render obvious the present invention under 35 USC §103(a).

With respect to pending claim 7, applicants also offer the following additional comments. Specifically, pending claim 7 has the extra feature that the molecular weight of the soft segments is between 2500 and 5000. This high molecular weight is made possible because of the low amount of unsaturation. In this regard, please see for example page 4, line 31 through page 5, line 1 of the subject application. Because of the higher molecular weight it is in turn possible to obtain very soft elastomers with better mechanical properties. See page 4, lines 15-19 and page 7, line 36 through page 8, line 6 of the subject application.

In contrast, according to Bonte et al only a high molecular weight (of 4000) is mentioned, but there is no disclosure at all to give a post treatment to the polyether in order to obtain the low unsaturation. If Bonte was able to produce the relatively high molecular weight, then the improved mechanical properties at such higher molecular weight were not obtained. Furthermore, it should be noted also that in Bonte et al the lower molecular weights are preferred (lower than 2500).

**GÖTZ**  
**Serial No. 10/587,947**  
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Only brief comments need to be made with respect to the combination of Tieke with Bonte et al to reject claims 14 and 15 under 35 USC §103(a). Specifically, as should now be apparent, even if one were to fashion the Bonte et al copolyetheresters into a film as suggested by Tieke, the present invention would still not be the result since the copolyetherester as claimed herein is patentably distinct from that disclosed by Bonte et al.

Withdrawal of the rejection advanced under 35 USC §103(a) against claims 14 and 15 is therefore also in order.

### **3. Fee Authorization**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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